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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 09/451,315 | 11/30/1999 | DALE F. MCINTYRE | 79909F-P | 8863 |
| 7590 05/19/2006 MILTON S. SALES EASTMAN KODAK COMPANY PATENT LEGAL STAFF 343 STATE STREET ROCHESTER, NY 14650-2201 | | | EXAMINER CARLSON, JEFFREY D | |
| | | | ART UNIT 3622 | PAPER NUMBER |
| DATE MAILED: 05/19/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/451,315

Applicant(s)

MCINTYRE ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 2/17/06.

Double Patenting

Claims 44-52 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-3, 5, 7, 13-16 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 7, 8, 10, 11, 13-17, 22, 23, 25, 26, 28-33, 44, 45, 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al (US5595389) in view of Small (US5791991).**

4. Regarding claims 1, 11, 14, 16, 44, 50, 52, Parulski et al teaches personalizing a computer game using the images of a user in order to provide a greater sense of affinity and immersion [1:22-23, 37-38]. The user's personal images come from a variety of sources including scanned prints, negatives, Kodak Photo CDs, etc [1:52-55, 3:24-28].

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The images and the game programming are both written to a CD product [1:55-61].

When the product is executed by a user's computer, the game is taken to locate and select a stored user image and incorporate the image into the gameplay. Parulski et al teaches that the game is a puzzle game [3:28], but does not provide details about any end-of-game messages. Small also teaches a computer-based puzzle game whereby the player is provided with status messages (i.e. "you win" or "you lose") [7:30-32, 48-49] regarding the outcome of puzzle game played. It would have been obvious to one of ordinary skill at the time of the invention to have provided the player of Parulski et al's puzzle game with any particular status message regarding the game's conclusion/outcome. Further, Official Notice is taken that it is well known to prompt a computer game player with messages in order to "play again?" or to "quit?" and it would have been alternatively or additionally have been obvious to one of ordinary skill at the time of the invention to have prompted a player with such messages in order to allow the player to continue.

5. Small teaches a computer game whereby a user of a personal computer or interactive TV is provided discount coupons and/or rebate information at the conclusion of the game; the user is then able to print coupons and rebate information [7:50-57]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a promotion/advertising/coupon component as taught by Small with the game of Parulski et al in order to provide sponsorship for the game, so as to add consumer value and/or to generate revenue or to offset costs for providing the game. The

communication to the user at the conclusion of the game is further taken to provide display of a message to the user.

6. Regarding claims 2, 7, 8, 10, 17, 22, 23, 25, 26, 31-33, 45, 48, Small teaches interaction between the user and remote computers via web sites over the Internet, including linking to web sites of participating manufacturers [col 5 lines 14-27]. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished such promotional/advertising information delivery by way of the links mentioned by Small at the conclusion of games, so that users can easily obtain such rebate information and can learn more about various products and browse the promoting manufacturer's web site(s). Providing links to manufacturer and product information pages at the conclusion of a game is taken to provide automated forwarding of a user to a remote computer site upon completion of the game; the user need not manually type in the URL/address of the destination site.

7. Regarding claims 13, 15, 28-30, 49, 51, Parulski et al teaches a puzzle game that includes a choice of 64 still, personalized images which the user chooses during gameplay [3:31-34]. This may be taken to meet applicant's claiming of a particular game, yet Small provides a computerized matching game with images covering "hidden" tiles. The computer uses images or a mosaic of images to provide the covering tile texture/surfaces. The game is Bingo, not concentration. However, Small teaches that other match games can be used instead [col 9 lines 12-15]. Official Notice is taken that the instantly described game of Concentration is a known game, where pairs of hidden cards/tiles are selected for matches to be revealed. It would have been

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obvious to one of ordinary skill at the time of the invention to have provided any type of computer game including the games of Small and/or "Concentration" in order to provide a variety of experiences. Small provides a square section game/puzzle and it would have been obvious to one of ordinary skill at the time of the invention to have provided the known Concentration matrix as one which is square as a matter of design choice.

8. Claims 3-6, 18-21, 46, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al in view of Small and Walker et al (US6203427).

9. Walker et al also teaches computer games. Each game/contest includes a gameID, customerID and winning information. The winning information is also encrypted [fig 11b, col 9 lines 1-25]. It would have been obvious to one of ordinary skill at the time of the invention to have provided such game/contest identification means so that a winning player must verify the authenticity of the winning contest by any well known means such as by phone or computer, so as to eliminate fraudulent tournament scores. Official Notice is taken that encryption is used when transmitting data for security and authenticity. It would have been obvious to one of ordinary skill at the time of the invention to have encrypted the contest and winning information to further secure against tournament fraud.

10. Claims 9, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al in view of Small and Barnett et al (US6336099). Small does not take

steps to prevent a user from printing multiple copies of coupons. Barnett et al also teaches electronic coupon distribution, but takes steps to ensure coupons can only be printed once [col 5 lines 47-62]. It would have been obvious to one of ordinary skill at the time of the invention to have prevented users from printing awarded coupons more than once, so as to eliminate fraud and to encourage playing multiple games, thus being subjected to more sponsorship promotion.

11. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al in view of Small (US5791991) and Von Kohorn (US5916024).

Parulski et al teaches that the game is provided on a CD medium. Von Kohorn teaches that computer games may be played on home computers whereby the game material (program) may be provided by an online (remote computer) source or by a CD containing the required game material [9:50 to 10:43]. Coupons can also be awarded to players based on their participation in the game. It would have been obvious to one of ordinary skill at the time of the invention to have provided the images and game program described by Parulski et al on the CD as described or by a remote computer system in a manner as described by Von Kohorn. This would enable the user to play the game from any connected computer without the need to tote the CD along.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc